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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
07/053,307	05/22/87	BEDNORZ	J Y0987-074

EXAMINER
BOYD, J

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ART UNIT	PAPER NUMBER
115	24

DATE MAILED: 04/25/91

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

2/13/91

This application has been examined Responsive to communication filed on 2/13/91 This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), 0 days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892.	2. <input type="checkbox"/> Notice re Patent Drawing, PTO-948.
3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449.	4. <input type="checkbox"/> Notice of Informal Patent Application, Form PTO-152
5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474.	6. <input type="checkbox"/> _____

Part II SUMMARY OF ACTION

1. Claims 1-95 are pending in the application.

Of the above, claims 12-26, 36-39, 55-59 + 64 are withdrawn from consideration.

2. Claims _____ have been cancelled.

3. Claims _____ are allowed.

4. Claims 1-11, 27-35, 40-54, 60-63 + 65-68 are rejected.

5. Claims _____ are objected to.

6. Claims _____ are subject to restriction or election requirement.

7. This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. Formal drawings are required in response to this Office action.

9. The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are acceptable; not acceptable (see explanation or Notice re Patent Drawing, PTO-948).

10. The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been approved by the examiner; disapproved by the examiner (see explanation).

11. The proposed drawing correction, filed _____, has been approved; disapproved (see explanation).

12. Acknowledgement is made of the claim for priority under U.S.C. 119. The certified copy has been received not been received been filed in parent application, serial no. _____; filed on _____

13. Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. Other

EXAMINER'S ACTION

1. Applicant's election with traverse of Group I in Paper No. 22 is acknowledged. The traversal is on the ground(s) that the claims of Groups I, II and III are not distinct. This is not found persuasive because the Examiner maintains that the superconductive product, process of making and method of use are directed to patentably distinct inventions. Although there are broad "process" and "method" claims that appear to encompass a great deal of subject matter, the limitations in the dependent claims distinguish the claims of the Groups I, II and III.

The requirement is still deemed proper and is therefore made FINAL.

2. The objection to the specification and objection of claims 1-11, 27-35, 40-54, 60-63 and 65-68 under 35 USC 112, first paragraph, is maintained.

3. The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to provide an enabling disclosure commensurate with the scope of the claims.

4. The Applicants assert that "the scope of the claims as presently worded is reasonable and fully merited" (page 17 of

response). The Examiner disagrees. The present claims are broad enough to include a substantial number of inoperable compositions.

5. The rejection of claims 1-11, 27-35, 40-54, 60-63 and 65-68 under 35 USC 112, second paragraph is maintained.

6. Claims 1-11, 27-35, 40-54, 60-63 and 65-68 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. The amended term "rare earth-like" is vague. With respect to the lack of stoichiometry, Applicants argue the superconductive properties can be measured as the composition is varied. This is unconvincing because the present claims broad enough to require an undue amount of experimentation.

8. The Examiner maintains that the term "doping" is vague. Neither the claim or the specification discuss the limits of the effective amounts of doping.

9. The Applicants assert that a discussion of "electron-phonon interactions to produce superconductivity" is found in the specification. The Examiner maintains that the term is not adequately explained. The specification fails to teach how one determines how to enhance the "electron-phonon" interactions?

10. The term "at least four elements" is indefinite considering the number of elements in the periodic table.

11. The rejection of claims 1-11, 27-35, 40-54, 60-63 and 65-68 under 35 USC 102/103 is maintained.

12. Claims 1-11, 27-35, 40-54, 60-63 and 65-68 are rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103 as obvious over each of Shaplygin et.al., Nguyen et.al., Michel et.al. (Mat. Res. Bull. and Revue de Chimie).

13. The Applicants argue that "no prima facie case has been made that the composition anticipates or renders obvious the subject matter" (page 28 of response). The Examiner maintains that these materials appear to be identical to those presently claimed except that the superconductive properties are not disclosed. Applicants have not provided any evidence that the compositions of the cited references are in any way excluded by the language of the present claims, i.e. Applicants have failed to show that these materials are not superconductive. Applicant's composition claims do not appear to exclude these materials.

14. Applicants further argue that under United States patent law they are entitled to claim compositions which might happen to overlap a portion of the concentration ranges broadly recited in the cited references. "The broad statement of a concentration range in the prior art does not necessarily preclude later invention within the concentration range" (page 29 of response). The Examiner fails to understand how Applicant's incredibly broad claims, some of

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which require only the presence of a "doped transition metal oxide" (see claim 42), in anyway fall "within" the scope of the compositions disclosed in the prior art. The cited references disclose very specific compositions that not only fall within the scope of the claims, but appear to be identical to those compositions disclosed in the specification as being superconducting. The Examiner maintains that these materials are inherently superconductive and therefore render the claim unpatentable.

15. With respect to Applicants arguments under 35 USC 103 regarding the "question of non-analogous art" and the assertion the cited prior art is irrevelant to the present claim, the Examiner maintains that for the present "composition" claims the references directed to what appear to be identical materials (both in composition and inherent properties) are clearly relevant. The cited individual disclosures appear to be sufficient to maintain the rejection, the Examiner is not relying on any secondary references to modify the teachings in the references.

16. The rejection of claims 1-2, 5-11, 40-44, 46, 48, 51-54, 60, 62 and 66 under 35 USC 102/103 is maintained.

17. Claims 1-2, 5-11, 40-44, 46, 48, 51-54, 60, 62 and 66 are rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103 as obvious over each of Perron-

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Simon et.al., Mossner et.al., Chincholkar et.al., Amad et.al., Blasse et.al., Kurihara et.al. and Anderton et.al.

18. This rejection is maintained for the reasons set forth in the previous paragraphs. The Examiner maintains that the cited references appear to disclose materials which inherently provide superconductive properties and therefore render the present claims unpatentable.

19. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Boyd whose telephone number is (703) 308-3314.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661.

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J. Boyd

April 24, 1991

Paul Lieberman

PAUL LIEBERMAN
SUPERVISORY PRIMARY EXAMINER
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